

REMARKS

Please consider the foregoing amendments and the following remarks in response to the Office Action mailed on November 25, 2003. The amendments made are minor in nature, serve to clarify the claimed invention and several are made in response to suggestions by the Examiner. They have been made to place the application in form for allowance or in better form for appeal and entry of the amendments is respectfully requested.

The clarifying amendments to claims 31-36, 46 and 48 are based upon the specification at paragraphs [0001], [0004], [0005], [0006], [0028], [0029] and [0034].

The claims pending in the application are 31-36 and 46-52 and claims 49-52 are newly submitted dependent claims. Claims 34 and 37 have also been written in multiple dependent form.

Election/Restriction

Applicants acknowledge the finality of the restriction requirement and claims 1-30 and 37-45 have been withdrawn.

Claim Rejections – 35 U.S.C. §112

Claims 46-48 have been amended in response to the rejection under 35 U.S.C. §112, second paragraph, in that the term “or the like” has been deleted from claims 46 and 48. In addition, claims 46-48 have been amended by replacing the term “or” with “and” in accordance with the requirements of Markush language under U.S. practice.

Withdrawal of the rejections under 35 U.S.C. §112 is accordingly respectfully requested.

Claim Objections

Claims 46 and 47 have been objected to under 37 C.F.R. §1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. In making the rejection, the Examiner has stated that it appears that the second mechanically embossed texture is not different from the first mechanically embossed texture based on limitations recited in claims 46 and 47. This rejection is respectfully traversed.

Claim 46 depends from claim 31 which refers only to a first mechanically embossed texture and claim 46 provides a Markush group of first mechanically embossed textures. Claim 47 depends from claim 33 which in turn depends from claim 31. Claim 33 requires, "a second mechanically embossed texture different from the first mechanically embossed texture." Accordingly, claim 47 must be read in the context of claim 33 from which it depends. Claim 47 provides a Markush group of second mechanically embossed textures and when read in the context of claim 33 it is clear that the texture or textures selected from the Markush group must be "different from the first mechanically embossed texture." Accordingly, claim 47 further limits the subject matter of claim 33 as required by 37 C.F.R. §1.75(c) and the texture of claim 47 must be different from the texture of claim 46 because claim 33 requires that the second

mechanically embossed texture must be different from the first mechanically embossed texture. Withdrawal of the objection is respectfully requested.

Claim Rejections – 35 U.S.C §103

In paragraph 7 of the Action, claims 31-33, 35, 46 and 48 are rejected under 35 U.S.C. §103(a) as being unpatentable over Courtoy, et al. (Re. 33,599) in view of Baskin (U.S. 4,877,656). In making the rejection, the Examiner alleges that Fig. 6 of Courtoy reads on the limitations of claim 33 arguing that the wear layer which is not disposed over the ink has a texture different from the first mechanically embossed texture, i.e., a portion of the wear layer located between “chemical embossed” and “mechanical embossed.” But Courtoy has no second mechanically embossed texture.

This is clear from Col. 7, Example 1 of Courtoy which describes the figures in detail and there is no teaching or suggestion from the description of a second mechanically embossed texture. Claim 33 doesn't simply claim a second texture different from the first mechanically embossed texture as suggested by the Examiner. The claim requires that the second texture must be a mechanically embossed texture. Courtoy does not teach each and every element of the claimed subject matter because Courtoy has to do with a process for obtaining selective areas of matting on synthetic coverings and products. As explained by applicants in paragraphs [003] and [004] of the pending application, the present invention is not directed to matting on surface coverings but it is directed to relatively deep embossing to produce a texture, for example, to imitate

cementitious grout. This distinction was explained in detail in applicants' previous amendment.

The teachings of Baskin as a secondary reference cannot overcome the deficiencies of Courtoy as a primary reference. Baskin teaches a method of fabricating simulated stone surfaces having relatively deep embossed depths. The reference has nothing to do with mechanical embossing. Furthermore, the embossing of Baskin is an overall embossing which is applied to the entire surface. This is substantially different from applicants' claims wherein, for example, the first embossed texture is in register with an ink containing a photoinitiator printed in a design. There is no teaching or suggestion in Baskin of any mechanism for preparing an in register embossed surface of the type described in applicants' claims. Accordingly, no combination of Baskin with Courtoy could be used to prepare applicants' claimed product and the rejection should be withdrawn.

In paragraph 8 of the Action, claims 31-36 and 46-48 are rejected under 35 U.S.C. §103(a) as being unpatentable over Chen, et al. (U.S. 6,555,216) as evidenced by Courtoy. In making the rejection, the Examiner alleges that Figs. 10 and 11 of Chen read on the limitations of claim 33, but Chen does not describe, illustrate or suggest any product having a cured coating or a cured layer overlaying a foamed plastic layer having an ink printed in a design thereon wherein the portion of the cured coating or cured layer disposed over the ink is chemically embossed and mechanically embossed with a first mechanically embossed texture. The chemically embossed portion of Chen does not contain any mechanical embossing according to Figs. 10 and 11 of Chen.

The addition of a photoinitiator from Courtoy to the ink of Chen would not produce the product of the presently claimed invention because Chen does not mechanically emboss the portions that are chemically embossed. The only mechanical embossing of Chen is in the raised portions of the surface and it cannot be in depressed portions because Chen mechanically embosses after the product has been chemically embossed to provide a product having a completely different structure from the product of applicants' claims. The teachings of Courtoy cannot overcome these deficiencies of Chen because the two inventions are based upon completely different processes which result in products having entirely different characteristics. Accordingly, the rejection over Chen as evidenced by Courtoy should be withdrawn.

In paragraph 10 of the Action, claims 34 and 36 are rejected under 35 U.S.C. §103(a) as being unpatentable over Courtoy in view of Baskin as applied to claim 31 above, further in view of Haemer, et al. (U.S. 4,298,646). Claims 34 and 36 depend from claims 31 and 35, respectively, and applicants have distinguished claims 31 and 35 from the combination of Courtoy and Baskin in the remarks set forth above. Accordingly, claims 34 and 36 should be allowed as dependent from allowable independent claims. Furthermore, Haemer has to do with differential gloss products and, as applicant has previously explained, the textures of applicants' claims are distinguished from the textures used to create a differential gloss or matte finish. The fact that Haemer may teach a surface covering comprising a polyurethane coating overlaying a cured coating is not sufficient to overcome the deficiencies of the primary

references and it fails to teach or suggest applicants' claimed structure. Withdrawal of the rejection is accordingly respectfully requested.

Double Patenting

The obviousness type double patenting rejection of claims 31-33, 35, 46 and 48 is respectfully traversed. Applicants' claims are patentably distinct from the combination of Courtoy and Baskin as asserted in the rejection and as explained by applicants in the foregoing remarks. Withdrawal of the double patenting rejection is accordingly requested.

Conclusion

The Examiner is invited to telephone the undersigned at 908-252-4256 if it is believed that further discussion may help to expedite the prosecution of the application.

A Notice of Allowance of claims 31-36 and 46-52 is respectfully requested.

Respectfully submitted,



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